PATENT - TEE

#8
JRP
12/6/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

ANDREI V. GUDKOV ET AL.

Serial No.: 09/880,417

Filed: June 13, 2001

For: **p53 INHIBITORS AND THERAPEUTIC USE OF THE SAME**

Attorney Docket No. 27611/37477

Group Art Unit: 1614

Examiner: Jerome Goldberg

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents Washington, D.C. 20231.

Dated: **November 26, 2002**

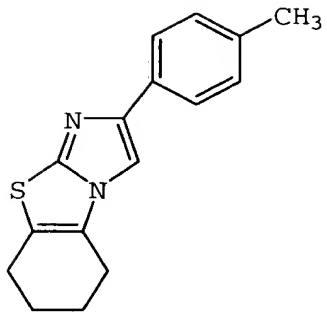
James J. Napoli
Registration No. 32,361
Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated October 18, 2002, applicants hereby elect the invention represented by the claims of Examiner's Group I, namely, claims 1, 3-26, 33-35, and 37-39, with traverse, for examination on the merits at this time. Applicants also elect, with traverse, the specific disease condition recited in claim 34, i.e., preparing a host for a bone marrow transplant. Finally, applicants elect, with traverse, the compound identified as (VI) at page 37 of the specification, i.e., 2-(4-methylphenyl)-5,6,7,8-tetrahydrobenzo[d]imidazo[2,1-6]thiazole, also termed pifithrin-beta or PFT-β, having a structure



It is submitted, however, that all claims 1 and 3 through 45, and all diseases and compounds of structural formulae (VI) and (IX)-(XI), should be examined at this time. The novelty of the invention is defined in the claims of both Group I and Group II, which are not two independent and distinct inventions because the statutory requirements of 35 U.S.C. §121, namely, independence and distinctness, are not present herein.

Although the claimed subject matter may be classified in different subclasses, the inventions are not independent because the subject matter set forth in claims 1, 3-26, 33-35, and 37-39, and the subject matter set forth in claims 27-32, 36, and 40-45, are so closely related that a search for applicants' Group I claims would necessarily encompass a search for applicants' Group II claims. In particular, all claims are directed to the temporary inhibition of p53. In addition, even if the inventions are considered independent, there is no evidence that a search and examination directed to all claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must exam-

ine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

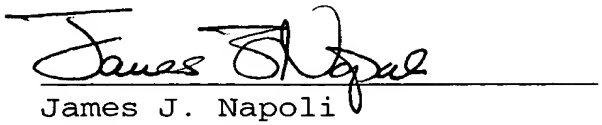
In particular, it is submitted that a complete search directed to the subject matter of the apparatus claims of examiner's Group I would require a search directed to the subject matter of the method claims of examiner's Group II, and vice versa.

Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute the method and apparatus claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the method and apparatus claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office and applicants to do so in two separate applications. Accordingly, it is submitted that all claims should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action of the merits on all claims is solicited.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

By 

James J. Napoli
(Registration No. 32,361)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 474-6300

Chicago, Illinois
November 26, 2002